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PATENT & TRADEMARK OFFICE THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Gary D. HODGEN et al. : Group Art Unit: 1614

Serial No.: 08/462,703 : Examiner: K. Jordan

Filed: June 5, 1995 :

For: **ANTIPROGESTIN METHOD AND KIT FOR REDUCING SIDE EFFECTS
ASSOCIATED WITH LOW DOSAGE HRT, ORAL CONTRACEPTION AND
REGULATING MENSES**

RESPONSE

Assistant Commissioner for Patents
Washington, D. C. 20231

Sir:

The following is responsive to the office action of March 4, 1999.

In further support of the rejection of claims 42-55 and 102-107 as allegedly obvious over Hodgen in view of Black, the examiner cites *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980), noting "the motivation to combine methods that are already known for the same purpose is well settled in patent law." However, applicants still feel that these claims are patentable for the reasons given in the response of December 9, 1998, especially in view of *Kerkhoven*.

Kerkhoven holds:

It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. [Citations omitted] As this court explained in Crockett, the idea of combining them flows logically from their having been individually taught in the prior art. In the case at bar, appealed claims 2-4, 9 and 14 require no more than the mixing together of two conventional spray-dried detergents. Thus, these claims set forth *prima facie* obvious subject matter.

Thus, the rationale of *Kerkhoven* applies when two "compositions" are useful for the same purpose and it is logical to combine them to form a third composition "which is to be used for the very same purpose." (emphasis added) However, as pointed out in applicants' prior

response, whereas contraception may be the end use of interest, the prior art "teachings" involve an ovulation-blocking modality and an ovulation-permissive modality. In other words, one of the "purposes" involves ovulation blocking whereas the other involves ovulation-permissiveness. The rationale of *Kerkhoven*, thus, does not apply since "the very same purpose(s)" are not involved. It is for this reason that there is no motivation to make the combination alleged by the examiner.

The examiner is thanked for her treatment of the double patenting and 37 C.F.R. 1.78(b) situations. Applicants fully agree and stand ready to cancel the necessary claims at the appropriate time.

Respectfully submitted,

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